

REMARKS

Claims 1-20 are pending in the instant application. Claims 1, 8 and 15 are independent claims, and claims 2-7, 9-14 and 16-20 depend, respectively, from independent claims 1, 8 and 15. Claims 1-20 stand rejected as being obvious in light of USP 5,280,430 ("Woods") in view of USP 5,414,754 ("Pugh"). The Applicants request reconsideration of the patentability of the claims in view of the following remarks.

First, the Pugh reference does not constitute analogous art. The present invention generally relates to a method for billing for use of a computer aided transcription system used by, for example, court reporters for real time transcription. The Pugh reference, on the other hand, discloses a telephone system that provides caller-controlled telephone services (such as conference calling) after a call is completed. Pugh is in no way related to a computer aided transcription system, and the Pugh reference makes no mention of real time transcription or billing for such acts. As such, the Pugh reference is clearly not within the same field of endeavor as the present invention.

In addition, the Pugh system is not reasonably pertinent to the particular problem(s) sought to be solved by the present invention. The present invention describes, generally speaking, a billing method that authorizes a party for a predetermined amount of real time transcribed text. The Pugh reference, however, makes no mention of such pre-authorization. As discussed in further detail below, the Pugh reference simply suggests that a phone call can be recorded and transcribed, with the bill being sent to the party requesting such recording and transcription. The Pugh reference, however, never suggests authorizing a user for a predetermined amount of transcription. As such, one of ordinary skill in the art would not have consulted the Pugh reference or applied its teachings in seeking a solution to the problem(s) that the present invention solves. Accordingly, the Pugh reference cannot be considered analogous art.

Because the Office Action concedes that the Woods reference does not, and cannot, render the present invention obvious by itself, removal of the Pugh reference undermines the Office Action's obviousness rejection. Thus, for this reason alone, Applicants respectfully submit that the rejection under §103 be withdrawn.

Moreover, even if the Pugh reference is found to be analogous art, Applicants respectfully submit that claims 1-20 are patentable even in light of the Woods and Pugh references because these references do not suggest or disclose each of the limitations claimed. In order for a *prima facie* case of obviousness to be established, Section 2142 of the MPEP states:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art.

If a *prima facie* case of obviousness is not established, the Applicants are under no obligation to submit evidence of nonobviousness. See MPEP Section 2142 ("The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."). The Applicants respectfully submit that the combination of references cited do not teach, nor suggest, each and every limitation of the claims, and, as such, a *prima facie* case of obviousness has not been established with respect to the rejection of the pending claims of the present application.

Independent claims 1, 8 and 15 all generally claim a method of billing that disables the transcribing after the predetermined amount of transcription has been reached. The Office Action readily admits that the Woods reference does not disclose this limitation. And contrary to the Office Action, Applicants assert that the Pugh reference does not disclose, suggest or teach this limitation either. The Pugh reference discloses a telephone system that allows one of the callers to request that a telephone conversation can be recorded. (See col. 7, lines 37-43, as cited by the office action). According to the Pugh reference, a transcription of the recorded call can be prepared and billed to the requesting caller. At no point does the Pugh reference suggest obtaining a predetermined amount of transcription, nor does it suggest stopping the transcription once the predetermined amount of transcription has been reached. Because neither the Woods nor the Pugh reference discloses this limitation, Applicants respectfully assert that the present claims cannot be obvious in light of the combination of these references.

The Office Action seems to suggest that even though none of the art of record specifically discloses or suggests this limitation, it would have been obvious to one of ordinary skill in the art to couple a computer aided transcription system to a remote system for authorization and to disable transcribing after the predetermined amount of transcription has been reached. However, the Office Action provides no support for the position. And while the Examiner obviously completed a thorough and detailed search of the prior art, the Examiner's search did not yield a single reference that the Examiner could cite to for this proposition. Moreover, because the subject matter is not of such "notorious character" that it is "capable of instant and unquestionable demonstration as being well-known," Applicants assert that the Examiner cannot take official notice of this fact under MPEP 2144.03. Accordingly, the Applicants request that the Examiner provide a reference(s) to support the Examiner's position if the Examiner intends to maintain any rejection based on the assertion. If the Examiner has any questions, the Examiner is invited and encouraged to contact the Applicant at the number below for further discussion.

Thus, for this reason as well, Applicants respectfully request that the rejection under § 103 be withdrawn.

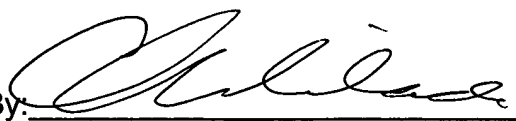
In addition, the Office Action fails to provide grounds for rejecting claims 4-6, 12 and 14. The Office Action grouped its rejection for claims 3-6 and 12-14, noting only that official notice was taken that payment by credit card was well known in the art. While claims 3 and 13 make reference to a credit card, remaining claims 4-6, 12 and 14 in no way claim or make reference to using a credit card. Accordingly, the Office Action's general rejection is completely inapplicable to claims 4-6, 12 and 14. Thus, for this reason as well, Applicants respectfully request that the § 103 rejection be withdrawn as to these claims.

Based on at least the foregoing, the Applicants believe that claims 1-20 are in condition for allowance. If the Examiner disagrees or has any question regarding this submission, the Applicants request that the Examiner telephone the undersigned at (312) 775-8000.

A Notice of Allowance is courteously solicited.

Respectfully submitted,

Dated: February 3, 2005

By: 
Christopher C. Winslade
Reg. No. 36,808

McAndrews, Held & Malloy, Ltd.
500 West Madison Street - Ste. 3400
Chicago, Illinois 60661
(312) 775-8000